

Application No. 10/666,697
Amendment dated December 1, 2005
Reply to Office Action of September 1, 2005

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REMARKS

Applicants appreciate the consideration shown by the Office, as evidenced by the Office Action, mailed on September 1, 2005. The Office Action rejected Claims 1-7, 10-17, 21-26, 28 and 29. The Office Action objected to Claims 8, 9, 18-20 and 27 and Claims 30-37 are withdrawn from consideration. As such, Claims 1-30 remain in the case.

The September 1, 2005, Office Action has been carefully considered. Applicants respectfully requests reconsideration of the application by the Examiner in light of the above amendments and the following remarks offered in response to the September 1, 2005, Office Action.

Rejections under 35 U.S.C. §112

The Office Action rejected Claim 10 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention.

Applicants have amended claim 10 by inserting "percent" between "atomic" and "Fe". The amendment does not include new matter and is not related to patentability, but corrects a typographical omission. Antecedent basis for the applicants' amendment may be found in the specification, such as paragraph 16.

Rejections under 35 U.S.C. §102

The Office Action rejected Claims 1-7 under 35 U.S.C. 102(b) as allegedly anticipated by Akioka U.S. 5,597,425 ('425).

The Office Action alleged that Akioka (column 12, Table 3) discloses sample 19 comprising Pr, Fe, and an alloy.

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Applicants respectfully submit that, in order to anticipate under §102, a reference must teach *each* and *every aspect* of the claimed invention and in order to anticipate, a prior art disclosure also be *enabling*, such that one of ordinary skill in the art could practice the invention without undue experimentation. SmithKline Beecham, 403 F.3d at 1342. Akioka only discloses and enables joining grains that have an average diameter less than about 150 um with a *resin* (i.e. a glue, binder, plastic, or other bonding agent substance to join the grains); Akioka fails to enable grains that have an average diameter less than about 150 (which are relatively microscopic as opposed to microscopic) without a *resin* to join them and thereby fails to anticipate. In fact, Akioka discloses the requirement of joining grains that have an average diameter such as less than about 150 um with a resin in several places such as the following: Fig. 1 states and requires "kneading with *resin*". Col. 6, line 22, only discloses an anisotropic magnet that is *resin-bonded*. Example 2 Table 3 in column 12 line 43 also only magnets that are *resin-bonded*. Example 3 in column 13 line 44-46 states "the powder of sample number 2 was kneaded with 2 weight percent of *epoxy resin*." Accordingly, Akioka only discloses and requires joining grains that have an average diameter less than about 150 um with a *resin* and fails to disclose grains with such average diameters without a *resin* (i.e. a glue, binder, plastic, or other bonding agent like substance) to join or bond the grains. Applicants therefore submit that because Akioka fails to teach each and every aspect of the claimed invention, the rejection of the claims under 35 U.S.C. §102(b) is successfully overcome.

Applicants' invention does not disclaim a *resin*, glue, binder, plastic, or other bonding agent like substance to join or bond grains or other alloy blocks on a macro-level.

Rejections under 35 U.S.C. §103(a)

The Office Action rejected Claims 10-13 under 35 U.S.C. §103(a) as allegedly unpatentable over Akioka.

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To establish a *prima facie* case of obviousness, the MPEP explicitly *requires* the Examiner to demonstrate all the following three criteria. First, there *must* be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine to the reference teachings. Second, there *must* be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must* teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPO2d 1438 (Fed. Cir. 1991). See MPEP § 2143 -§ 2143.03.

Furthermore, in order to be obvious, the prior art must also enable the suggested motivation. In re Kumar, 418 F.3d 1361. As previously stated, Akioka only discloses and requires joining grains that have an average diameter less than about 150 um with a *resin* (i.e. a glue, binder or plastic like substance to join the grains) and fails to enable and disclose grains with such average diameter without a *resin* joining them.

The test for non-obviousness is not whether it would be merely advantageous or possible to combine references but whether the prior art suggests the motivation to combine the references. "[T]he mere fact that the references can be combined or modified does not make the resultant combination obvious unless the prior art suggests the desirability of the combination". In re Mills, 916 F.2d 680, 16 USPO2d 1430 (Fed. Cir. 1990); See MPEP section 2143.01

"The initial *burden is on the examiner* to provide some suggestion or motivation to modify and a reasonable expectation of success." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985); See MPEP § 2144 -§ 2144. The teaching or suggestion to make the modification and the reasonable expectation of success must both be found in the reference. In re Vaeck, 947 F.2d 488, 20 USPO2d 1438 (Fed. Cir. 1991). See MPEP § 2143 -§ 2143.03. When the motivation to modify the teachings of the reference is not

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immediately apparent, it is the duty of the examiner to explain why the modification of the teaching is proper.

In this case, Akioka only discloses and requires joining grains that have an average diameter less than about 150 μm with a *resin* and the Office Action fails to demonstrate any motivation to modify Akioka to disclose and enable grains with such average diameters without a *resin* to join or bond the grains. Furthermore, the Office Action also fails to demonstrate a reasonable expectation of success in modifying Akioka to disclose and enable grains with such average diameters without a *resin* to join or bond the grains. In fact, the Office Action fails to demonstrate *any* expectation of success in modifying Akioka to disclose grains with such average diameters without a *resin* to join or bond the grains as Akioka actually teaches away by only and expressly disclosing and requiring joining grains that have an average diameter less than about 150 μm with a *resin* (i.e. a glue, binder, plastic, or other bonding agent like substance) to join or bond the grains.

Double Patenting

The Office Action rejected Claims 14-16 under the judicially created doctrine of obviousness-type double patent as being unpatentable over claims 2, 21 and 23 of U.S. 6,518,867 in view of Akioka, cited above.

The Office Action provisionally rejected Claims 14-17 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 64 of copending Application No. 10/309,146 in view of Akioka, cited above.

The Office Action also rejected Claims 21-26, 28 and 29 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 7 and 12 of U.S. 6,525,634 in view of Akioka, cited above.

As stated above, Akioka only discloses and requires joining grains that have an average diameter less than about 150 μm with a *resin* (i.e. a glue, binder or plastic like


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substance to join the grains) and fails to disclose and enable grains with such average diameter without a *resin* joining them. Hence, the claims cannot be obvious in view of Akioka and the respective references, U.S.6,518,867, copending Application No. 10/309,146, and U.S.6525634. Furthermore, U.S.6,518,867, copending Application No. 10/309,146, and U.S.6525634 individually fail to anticipate the claims.

In light of the amendment and remarks presented herein, Applicants submit that the case is in condition for immediate allowance and respectfully requests such action. If, however, any issues remain unresolved, the Examiner is invited to telephone the Applicants's counsel at the number provided below.

Respectfully submitted,


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Date